

REMARKS

The Office Action of August 6, 2004 has been carefully studied. The following paragraphs correspond to the order of the paragraphs of the Office Action. The claims in the case are now 1-24 with claims 20-24 being newly added. Payment for these claims is attended to by the attached check. Thus far, no claim has yet to be allowed.

Abstract of the Disclosure

The abstract of the disclosure is now set forth in a separate paper and substantially conforms to the recommended language.

Brief Description of all the Figures

A brief description of figures 1, 2, 3 and 4 is now found on page 25.

Claim Objections

The Examiner is thanked for noting that the word "subjecting" was missing in claims 8, 10 and 11, and these claims are amended accordingly.

Claim Rejections - 35 U.S.C. 103

Before commenting on the contents of the cited prior art, Applicants respectfully note that the objective of the present invention is to produce a high quality oil having a high viscosity index, a low content of aromatic compounds, a good UV stability and a low pour point. Claim 1 in the present application recites a complex multi-step system in a highly crowded art. In order to provide a rejection under 35 U.S.C. 103, it is incumbent on the Patent Office to provide not only multiple references, but also to provide a motivation of why one of ordinary skill in the art would combine the references in this complicated field in order to arrive at Applicants' multi-step invention. In other words, absent motivation, Applicants' invention is unobvious under 35 U.S.C. 103 in the light of modern precedent.

So as to remove any doubt, if there should be any, of the unobviousness and patentability of the present invention, attached is a Declaration by Germain Martino which shows the

unexpected importance of the use of a lower temperature of 20-200°C in the hydrofinishing step than that used in the catalytic hydro-dewaxing step. More specifically, Example 1 in the Declaration employs a temperature difference of 75°C and Example 2 employs a difference of 15°C. As evident from the results, the process of Example 2 did not permit the production of an oil having as good a quality as that of Example 1, particularly with respect to the content of aromatic compounds. Also the yield in Example 2 is lower than in Example 1. The importance of utilizing the lower temperature in the hydrofinishing step is not at all suggested in the prior art, much less the unexpected results achieved.

With respect to the cited prior art of WO 98/02503 and Goudrian et al. (U.S. 4,062,758), the Examiner has elucidated the teachings and deficiencies of these references, and at this juncture, Applicants need not offer a rebuttal with respect to same, but reserve the right to do so at a later date if ever deemed necessary.

On page 5 of the Office Action, the last three paragraphs are set forth in order to attempt to explain why it would have been obvious to one of ordinary skill in the art to combine the references. However, Applicants respectfully disagree with the reasons on page 5 inasmuch as they are speculative conclusionary statements based on Applicants' invention. For example, with respect to the statement that it would have been obvious to modify the hydrofinishing conditions because one would utilize any conditions including those that are claimed in order to produce a product having any desired characteristics, would appear to preclude any further inventive improvements in this highly crowded art; yet it is by virtue of inventive improvements in this field that progress is made. In essence, the three paragraphs in the Office Action amount to hindsight reconstruction without a reasonable basis for such reconstruction. Accordingly, it is respectfully submitted that Applicants' process is unobvious under 35 U.S.C. 103 in this crowded art, and is deserving of patent protection.

As an additional comment, Applicants wish to point out that WO 98/02503 discloses ZSM-48 only in a long list of zeolites (page 13, lines 10-23) and this zeolite has neither been exemplified nor claimed. Instead, the realistic teachings of this reference would lead one of ordinary skill in the art to the use of zeolite SSZ-32 which is the exemplified zeolite in this patent.


Newly Added Claims

Newly added claim 20 and claims dependent thereon, 22 and 24 are supported by page 21, line 7 wherein the hydrofinishing step is lower by 30-100°C than the hydrodewaxing stage. Claim 21 is specific to the use of ZSM-48 as the catalyst and claim 23 is specific to the use of zeolites EU-2, EU-11 or ZBM-30.

In view of the above amendments to the abstract, specification and claims, the above remarks and the attached Declaration, it appears that the application is in condition for allowance. However, if there are any remaining issues which can be expeditiously resolved by a telephone conference, the Examiner is courteously invited to telephone Counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,


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